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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,896	04/27/2001	Masaharu Hayashi	0425-0836P	7584
2292 7590 06/23/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
PRYOR, ALTON NATHANIEL				
ART UNIT		PAPER NUMBER		
1616				
NOTIFICATION DATE		DELIVERY MODE		
06/23/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

09/842,896

Applicant(s)

HAYASHI ET AL.

Examiner

ALTON N. PRYOR

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 16, 18 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 16, 18 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments filed 3/13/08 have been fully considered but they are not persuasive. See discussion below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10,16,18 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2,5,6 of U.S. Patent No. 6884759. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions teach a plant activating composition comprising a mono alcohol. Claim 2 of USPN '759 discloses that the composition may also contain a surfactant (ester group containing nonionic surfactant) and / or a fertilizer. USPN '759 discloses that the monoalcohol may be present in 100 parts of the total composition. See column 5 lines 61-67. The claims of the instant invention and the

USPN '759 differ in scope, i.e. the instant invention requires the surfactant and fertilizer whereas the USPN '759 requires the monoalcohol along with surfactant and / or fertilizer. Because of the USPN '759 teaching the instant invention making claim to a composition comprising a monoalcohol, surfactant, and fertilizer is made obvious.

Response to Applicants' Argument

Applicants argue that with respect to claims 2 and 6 of USPN '759, claims 2 and 6 do not recite the compounds of Formula (II) as recited in present claim 10. Claim 10 has been amended to exclude compounds of formula (II) wherein X1 is hydrogen and n is 1-30. The remaining compounds of formula (II) do not have surface-activity and would not be considered surfactants.

The Examiner argues that in instant formula II when n = zero, X1 = hydrogen renders formula II as a fatty acid surfactants. Note, USPN '759 discloses at column 4 lines 3-8 fatty acid surfactants. The fatty surfactants disclosed in USPN '759 read on the instant formula II fatty acid surfactants when n = zero and X1 = hydrogen. For this reason USPN '759 makes instant fatty acid surfactants of formula II obvious.

Claims 10,16,18 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6489269. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions teach a plant activating composition / method comprising a mono alcohol, chelating agent, surfactant, (carboxylic acid, phosphoric acid, ester group containing nonionic surfactant) and fertilizer. USPN '269 discloses that the monoalcohol may be present in 100 parts of the total composition.

See column 6 lines 4-14. The claims of the instant invention and the claims recited in USPN '269 differ in scope, i.e. the instant claims employ "comprising" language" and claims of the USPN '269 employ "consisting essentially of" language. Although the scope of the claims differs, both the instant claims and claims in USPN '269 require the same ingredients (monoalcohol, surfactant and fertilizer). For this reason the claims in USPN '269 makes obvious the instant claims.

Response to Applicants' Argument

Applicants argue that with respect to claims 2 and 6 of USPN '269, claims 2 and 6 do not recite the compounds of Formula (II) as recited in present claim 10. Claim 10 has been amended to exclude compounds of formula (II) wherein X1 is hydrogen and n is 1-30. The remaining compounds of formula (II) do not have surface-activity and would not be considered surfactants.

The Examiner argues that in instant formula II when $n = \text{zero}$, $X1 = \text{hydrogen}$ renders formula II as a fatty acid surfactants. Note, USPN '269 discloses at column 4 lines 3-8 fatty acid surfactants. The fatty surfactants disclosed in USPN '269 read on the instant formula II fatty acid surfactants when $n = \text{zero}$ and $X1 = \text{hydrogen}$. For this reason USPN '269 makes instant fatty acid surfactants of formula II obvious.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Alton N. Pryor/

Primary Examiner, Art Unit 1616